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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,074	07/22/2003	Tetsuo Nakatsu	9639/1L323US2	9449

7590 06/16/2004  
Thomas R. Morrison  
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Mount Vernon, NY 10550

EXAMINER

KIM, VICKIE Y

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/625,074	NAKATSU ET AL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Vickie Kim	1614	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08-2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Status of application*

1. This application appears to be a division of Application No. 09/498592, filed 02/04/2000.

Applicant's claim for domestic priority under 35 U.S.C. 120 is acknowledged.

### *Claim Rejections - 35 USC 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 16-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kupper (WO 97/02273).

The claims read on a METHOD of imparting an immediate sensation to the mucous membrane, oral cavity, throat, or skin, comprising applying a sensate composition consisting essentially of a cooling sensate(e.g. 3-1-methoxypropane 1,2 diol), a warming sensate(e.g. vanillin alkyl ether), a tingling sensate(e.g. Jambu or pepper oleoresin) and a carrier or diluent.

Kupper(WO'273, hereafter) teaches a method of providing an enhanced sensory signal to the users incorporating a sensate composition to the healthcare products, wherein the sensate composition comprising a mixture of 3-1-methoxypropane 1,2 diol(pages10-11), vanillin alkyl ethers(page 9, lines 24-35 ), Jambu or pepper oleoresin and a carrier, wherein the composition is utilized in medication, cosmetics or toiletries, see claims, especially claims 1, 6 and 10. Kupper

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teaches that 3-1-methoxypropane 1,2 diol as a cooling sensate and vanillin alkyl ethers as a warming sensate, respectively.

Kupper's teaching(US'273) is different from applicant's claims because Kupper does not explicitly call Jambu or pepper oleoresin as a tingling sensate in the exemplified composition, whereas Kupper called Jambu or pepper oleoresin as warming sensate.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to add Jambu or pepper oleoresin into the patented composition to provide improved sensory signal because Kupper strongly suggest the addition of Jambu or pepper oleoresin for achieving improved perceived sensation of warmth, see claims 6. Especially, based on the patented claims suggested by the patented claims 1, 6 and 10, one would have motivated to add Jambu or pepper oleoresin into the patented composition because Jambu or pepper oleoresin(from claim 6) made from different origins than that of other warming sensates(taught by WO'273) and have different warming sensation than others. It is noted that the tingling sensation is inherent property and the tingling sensation would have obtained naturally when Jambu or pepper oleoresin is used. One would have been motivated to incorporate the sensate composition into the healthcare product or food product to improve the perceived sensation wherein a sensate composition consisting essentially vanillin alkyl ether(from claim 1), Jambu or pepper oleoresin(from claim 6), and 3-1-methoxypropane 1,2 diol (from claim 10), because it is always desirable to improve aesthetic qualities of the final product. The aesthetic qualities such as taste, smell, mouthfeel and after-taste are important concerns for consumer acceptability and it is also critical factor for the successful result where the patient compliance and user satisfaction

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are directly correspond to the outcome(result). Thus, one would have been motivated to maximize the sensory signal as evidenced by Kupper's patent using mixture of different sensates.

One would have been motivated to add Jambu into his patented composition to obtain extra benefit and to enhance the efficacy of the composition. One would have been motivated to do so, with reasonable expectation of the success, because the techniques and the skill to make such modification are considered to be conventional and commonly practiced in the state of the art as evidenced by Kupper's patent. Since Jambu possesses tingling sensation(as evidenced by the instant application), the modified composition inherently met the claims and renders the claims obvious, absent evidence to the contrary.

It is always desirable to extend the selection option for different products. The techniques and skills required for making such substitution is conventional knowledge or well within the skills of ordinary artisan as evidenced by Kupper's teaching. Since all the ingredients are proven to be safe and effective agents providing a sensory signal to users, it would have been utilized not only for cosmetic(lotion, deodorant), personal care(e.g. toothpaste), pharmaceutical products(e.g. nebulizer, a medicated lozenge) but also for nutritional food products(e.g. candy) as evidenced by WO'273, page 1, lines 11-12.

One would have been motivated to select one from each sensate category and so that the mixture of different sensates provide maximum sensory signals to the user by improving the perceived efficacy of the final products. It is critical and essential to consider consumer's preference and satisfaction with a product because the user's acceptability and compliance are directly related to the success in the industry. Since the mixture of these said ingredients(a cooling, a warming and a tingling sensates) set forth above in both Kupper's patent and instant

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application would effectively deliver pleasing aesthetics, better taste and masking effect of the bad tastes and smells originated from different materials.

All the pending claims are obvious over the teaching of the prior art of the record and thus, the claimed subject matter is not considered to be patentably distinct.

***Conclusion***

3. No claim is allowed.
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 571-272-0579(fax: 571-273-0579). The examiner can normally be reached on Tuesday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on 571-272-0584. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-3165 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

**VICKIE KIM  
PRIMARY EXAMINER**

Vickie Kim  
June 14, 2004  
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